

## REMARKS/ARGUMENTS

### New Matter Rejection

The Examiner in charge of the parent application (U.S. Patent Application No. 10/109,409) entered a final rejection on September 3, 2003. The Examiner ruled, incorrectly it is believed, that an amendment to the abstract added new matter in contravention of 35 USC Section 132. According to the Examiner, “[t]he added material, which is not supported by the original disclosure, is as follows: an outer core including a “top wall” portion.” Contrary to the Examiner’s ruling, the original drawings clearly show that the outer core 15 includes a continuous top wall portion.

In the originally filed Figure 2 sketch, (“an enlarged isometric assembly view . . . of the present invention.” (Specification page 4, lines 12-14)) the top wall portion of core 15 is shown as an uninterrupted quadrilateral in the shape of a rhombus, a closed form of four lines defining an area. There are no other lines or indicia within the Figure 2 top surface quadrilateral that could support a ruling that the outer core structure lacks a top wall portion. In the Figure 3 enlarged “x-ray” view in elevation, the outer core 15 is shown to be a continuous structure having thicknesses defining opposite sidewalls connected together by a top wall. The sidewall and top wall thicknesses are defined by a continuous dashed (dotted) line showing the interior walls of the sidewalls and the top wall. The two corner edge chamfers are also shown in Figure 3. The outer corner edge chamfers 30 are also shown in Figure 4 along with the four continuous sidewalls.

The originally filed specification summarizes the outer core element of the invention in these terms: “. . .an outer core of magnetic core material including structure overlying the coil and inner core and having opposite inner walls facing polar ends of the coil and core. . .” (Specification, page 2, lines 30 to 32 within paragraph [0008], (emphasis added)). The detailed description of the disclosed embodiment describes the outer core as “an outer box-like structure 15” (Specification, page 5, line 2 within paragraph [0019]). The term “box” is universally defined and understood as a container, usually rectangular and lidded. Thus, the term box-shaped, used in its ordinary dictionary definition meaning, means what is shown in the original figures to be a five sided structure including four continuous sidewall portions and a continuous top wall portion (i.e. a box lid).

In approving drawing amendments presented in the original application, the Examiner approved addition of reference numeral 21 to mark the originally discussed “facing inner

walls 21 of the outer core 15.” The reference numeral lead lines added by this approved drawing amendment extend to the single continuous broken line denoting the interior limit of the thickness of the sidewall portions. The same single continuous broken line to which reference numeral 21 lead lines extend shows and defines the thickness of the continuous top wall portion. If the Examiner agrees that the drawings show the sidewalls to have thickness forming facing inner walls justifying addition of reference numerals 21, then the drawings also show the top wall portion is existent and has a similar thickness. Thus, the original drawings show a continuous top wall portion (Figure 2) having a thickness (Figure 3) in the same manner as the side walls have a thickness and define interior end walls 21 as readily understood and agreed to by the Examiner.

It is not necessary to satisfy the written description requirement of 35 USC 112, first paragraph, that an element be expressly noted in the text of the original specification. The law is clear that whatever the original drawings of a patent application disclose to a person of skill in the art “may be added to the specification in word without violation of the statute and rule which prohibit “new matter” 35 USC 132, Rule 118 (now 37 CFR 1.121(f)) for the simple reason that what is originally disclosed cannot be “new matter” within the meaning of this law. If the drawing, then, contains the necessary disclosure, it can ‘form the basis of a valid claim’” In re Wolfensperger, 302 F.2d 950, 955, 133 USPQ2d 537, 542 (CCPA 1962, Judge Rich) cited with approval by the Federal Circuit in Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1565 (Fed.Cir. 1991). Also see In re Heinle, 342 F.2d 1001, 145 USPQ 131, 136 (CCPA 1965) (“...drawings and the specification may be amended to conform to each other and ... added matter will not be deemed technical “new matter” within the prohibition of the law.”)

Accordingly, it is not “new matter” of a type proscribed by 35 USC Section 132 for Applicants to add the language “top wall portion” either to the specification or to the claims of this application. Reconsideration in light of these points is requested.

#### Indefiniteness Rejection 35 USC 112 Second Paragraph

The Examiner rejected claims 7 and 18, reasoning that the drawings show the claimed recess to be between the inner core and the outer core. This is not the case. The claimed recess is exemplified by recess 23 formed in one end of the inner core, as clearly shown in Figure 2 and as shown in broken outline view in Figure 3. While there are recesses between the inner core and the outer core, the claimed recess is the one exemplified by the element identified by reference numeral 23. The specification teaches: “A primary function of the recess 23 is to adjust the saturation characteristic of a particular inductor assembly by control

of relative shape of the recess.” (Specification, page 5, lines 18-19). The claimed recess can be defined equally effectively in the inner core 16 or in the facing inner sidewall 21 as recited in claims 7 and 18. Reconsideration of this rejection is requested.

#### Prior Art Rejections

The following documents were cited by the Examiner in the Office Action mailed March 19, 2003 and are of record in the parent application:

#### U.S. PATENT DOCUMENTS

<u>Ref.</u>	<u>Document Number</u>	<u>Date</u>	<u>Name</u>	<u>Class</u>	<u>Subclass</u>
A	5,347,255	09/1994	Saitoh et al	336	83
B	6,252,486	06/2001	Wolf	336	200
C	6,285,272	09/2001	Boytor et al.	336	83
D	6,392,519	05/2002	Ronning	336	90
E	6,456,183	09/2002	Basteres et al.	336	200

#### FOREIGN PATENT DOCUMENTS

<u>Ref</u>	<u>Document number</u>	<u>Date</u>	<u>Country</u>	<u>Name</u>	<u>Translation enclosed (?)</u>
N	EP 1 032 001A1	02/2000	France	Basteres	

In the final office action in the parent application, mailed on September 3, 2003, the Examiner made the following comments regarding Applicants’ arguments filed June 18, 2003:

“Regarding arguments pertaining to claims 1, 3, 8, and 11, applicant asserts that the Saitoh reference does not disclose nor illustrate a ‘top wall and sidewall structure overlying the coil and inner core as recited by amended claim 1’. However applicant has incorporated new matter (top-wall), which was not discussed nor illustrated in the originally filed application. This limitation was not given patentable weight during examination. . . . Applicant simply states on page 5 of the disclosure of the application, a ‘box-like structure’. Examiner maintains art rejection.” (Office Action mailed in parent application on 9/3/2002, page 8, lines 8-13).

The Applicants’ remarks above directed to the “new matter” issue are incorporated herein by reference. Applicants respectfully assert that the top wall structure is fully and sufficiently illustrated in the original drawings filed in this application, that the original specification not only expressly states “box shape” at page 5 but also states that the outer core

includes structure “overlying” the coil and inner core at page 2. Therefore, the limitation “top wall and sidewall structure” is not technically new matter and is legally entitled to patentable weight in the further examination of this application.

When the originally disclosed “top wall” element is recognized and given its proper weight by the Examiner, Applicant’s comments distinguishing Saitoh et al. remain unrefuted:

“Applicants respectfully disagree that Saitoh et al. shows a “box” shape. Rather, the Saitoh et al. outer magnetic member 2, while providing a closed magnetic flux path or loop, structurally defines an open rectangular frame and not a box. The Saitoh et al. open frame lacks a cover.

“While the Saitoh et al. open frame magnetic member is adapted to conduct magnetic flux, it is not “topwall and sidewall structure overlying the coil and inner core” as recited by amended claim 1. The expression “overlying the coil” is used in its ordinary dictionary sense of lying over, i.e. covering the coil. The Saitoh et al. open frame outer member does not include a topwall structure overlying the coil.” (Applicants’ Amendment in parent application, filed on June 18, 2003, page 8, lines 10-18).

#### Disclosure Under 37 CFR § 1.56

In fulfilling the duty of candor and good faith, the following documents are hereby disclosed to the Patent Office in accordance with 37 CFR § 1.56. It is not admitted that the information in the listed documents is material to patentability as defined in 37 CFR § 1.56(b). The Examiner is requested to consider the documents in the examination of this application.

Accompanying this statement is a Form PTO-1449 in duplicate on which the documents are listed. The Examiner is requested to return an initialed and signed copy of the form once the documents have been considered.

The following documents were cited by the European Patent Office in the International Search Report dated June 23, 2003 for International Application No. PCT/US 03/07493 which is a counterpart for this application. Two of the documents were cited in category “X” as a “document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone”. The remaining documents were cited in category “A” each as a document

“defining the general state of the art which is not considered to be of particular relevance”. A copy of the Search Report is attached.

#### U.S. PATENT DOCUMENTS

<u>Document Number</u>	<u>Date</u>	<u>Name</u>	<u>Class</u>	<u>Subclass</u>	<u>Category</u>
4,160,966	07/1979	Kennedy	336	155	A
4,696,100	09/1987	Yamamoto et al.	29	605	A

#### FOREIGN PATENT DOCUMENTS

<u>Document number</u>	<u>Date</u>	<u>Country</u>	<u>Translation enclosed (?)</u>	<u>Category</u>
DE 951826C	11/1956	Germany	No	X
DE 1046796B	12/1958	Germany	No	X
DE 3615307A	11/1987	Germany	No	A
DE 4432739A	03/1996	Germany	No	A
GB 2284102	05/1995	Great Britain		A
WO 99/17318A	04/1999	International	Abstract	A

#### OTHER DOCUMENTS

<u>Details of Document</u>	<u>Category</u>
Patent Abstracts of Japan, vol. 1998, no.10, August 31, 1998 & Japanese Publication No. JP 10-135044 A (Kawasaki Steel Corp.), May 22, 1998 (abstract only)	A

In addition to the documents from the International Search Report, and the documents referred to above as having been cited by the Examiner, the following additional documents were cited by either the Examiner or the Applicants during the prosecution of the parent application.

#### U.S. PATENT DOCUMENTS

<u>Document number</u>	<u>Date</u>	<u>Name</u>	<u>Class</u>	<u>Subclass</u>
4,118,103	10/1978	Leidy et al.	339	98
4,424,504	01/1984	Mitsui et al.	336	83
4,602,122	07/1986	Lint	174	52.1
4,754,370	06/1988	DeTizio et al.	361	404
4,760,366	07/1988	Mitsui	336	233
4,760,366	07/1988	Mitsui	336	233
4,777,461	10/1988	Sakamoto	333	184
4,962,361	10/1990	Ida	336	90
5,212,345	05/1993	Gutierrez	174	52.5

5,309,130	05/1994	Lint	336	65
5,351,167	09/1994	Wai et al.	361	760
5,760,669	06/1998	Dangler et al.	336	65

#### Copies of Documents

In accordance with 37 CFR §1.98(d), copies of the documents submitted by Applicants during the prosecution of the parent application are not being submitted. In accordance with the Official Gazette Notice dated July 11, 2003, waiving the requirement under 37 CFR § 1.98(a)(2)(i) for submitting a copy of each cited U.S. patent and each cited U.S. patent application publication for all U.S. national patent applications filed after June 30, 2003, copies of the U.S. documents cited by the Examiner during prosecution, are not being sent. Copies of European Publication No. EP 1 032 001A1, which was cited by the Examiner, as well as the International Search Report, are enclosed. All of these documents referred to above are listed on the accompanying Form PTO-1449, and Applicants will readily supply copies of any documents if needed.

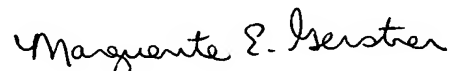
#### Fee

Applicants believe that because this Disclosure Statement is being submitted within three months of the filing date, no fee is due. If this is incorrect, please charge any necessary fee to Deposit Account No. 18-0560.

#### Conclusion

This preliminary amendment is being presented within three months of the filing of this continuation patent application. Accordingly, entry is requested in accordance with 37 CFR 1.115(b)(2)(i). Examination and early allowance of the claims of this application, as amended herein, is respectfully requested.

Respectfully submitted,



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